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UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 25 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROMAN M. GOLICZ and STEFAN G. GOLICZ

Application 08/962,077

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on June 8, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On June 1, 2004, applicants appear to have filed an untimely Reply Brief (Paper No. 38).

In accordance with the revision effective December 1, 1997, Title 37, Code of Federal Regulations, §1.193 states:

(b) (1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See §1.136(b) for extensions of time for filing a reply brief in a patent application and §1.550(c) for extensions of time

for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

In addition to the Reply Brief, applicants provide a request for an extension of time under 37 CFR §1.136(a). However, as set forth in 37 CFR § 1.193(b)(1), applicants are required to file extensions of time for a reply brief under 37 CFR § 1.136(b). Thus, it appears that the Reply Brief is untimely filed.

The examiner, upon receipt of this return, must determine if the Reply Brief is timely filed. If the examiner determines that it is untimely filed, the examiner needs to inform applicants that the Reply Brief will not be entered. If the Examiner decides that the Reply Brief was timely filed, proper response to the Reply Brief is required.

On page 3, section (9), of the Examiner's Answer mailed February 27, 2004 (Paper No. 37), the examiner cites Japanese reference 60-97141 (Watanabe). However, only an abstract of the reference is provided in English. A translation of the entire reference is required.

Further review of the Examiner's Answer reveals that the appeal conference was not properly noted. MPEP §1208 regarding appeal conferences states:

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On the examiner's answer, below the primary examiner's signature, the word "Conferees" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. (Emphasis added.)

The conferee's initials are missing from the examiner's answer.

Finally, an amendment after final rejection was filed on February 11, 2003 (Paper No. 27). On June 4, 2003, the examiner states in an advisory action (Paper No. 32) that the February 11, 2003 amendment is to be entered for purposes of appeal. The examiner's request for entry of the amendment is also noted by the examiner on the first page of the amendment. However, the amendment has not been physically entered into the record. Physical entry of the amendment is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to determine if the Reply Brief filed June 1, 2004 was timely filed;
- 2) if untimely filed, provide written notification to applicants that the Reply Brief was untimely;
- 3) if timely filed, provide proper response to the Reply Brief;

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- 4) to provide an English translation of the Watanabe reference;
- 5) to take corrective action regarding the appeal conference and provide applicants written notification of the action taken;
- 6) for physical entry of the February 11, 2003 amendment and;
- 7) for such further action as may be appropriate.

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By:



Kimberly Jordan
Program and Resource Administrator
(703) 308-9797

KJ/eld
RA04-0617

cc: Charles G. Nessler
P. O. Box H
Chester, CT 06412